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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/707,019

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Matthew Hunt

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EXAMINER

BOES, TERENCE

ART UNIT

PAPER NUMBER

3656

NOTIFICATION DATE

DELIVERY MODE

02/27/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<i>Office Action Summary</i>	Application No.	Applicant(s)	
	10/707,019	HUNT ET AL.	
	Examiner	Art Unit	
	TERENCE BOES	3656	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 February 2009.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 and 23-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 11-23 and 26 is/are rejected.
- 7) ☒ Claim(s) 7-10, 24 and 25 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 February 2009 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Request for Continued Examination

1. The request filed on 02/05/2009 for a Continued Examination (RCE) is accepted and a continued prosecution application has been established. An action on the RCE follows.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Art Unit: 3656

2. Claims 16-21 and 23 are rejected under 35 U.S.C. 102(e) as being anticipated by Kuo US 6,767,024.

Kuo discloses:

- a body (30) attachable to a handlebar (C) of the handlebar-steered vehicle;
- an actuator assembly (22, B) including a lever arm (see arm portion of 22) in pivoting engagement with the body (30) about a pivot axis,
- the lever arm associated with a suspension adjust cable (B),
- the actuator assembly having a first position corresponding to a first suspension setting (C3/L25-50, the position of the actuator shown in figure 4B) and a second position (C3/L25-50, the position shown in figure 4) corresponding to a second suspension setting;
- an actuator control assembly (20, 21) including an adjustment assembly (21, 20) associated with each of the body (30) and the actuator assembly,
- wherein the actuator control assembly further includes a locking assembly (231, 13)
- wherein the locking assembly includes a push-button (231) associated with the body,
- wherein the locking assembly further comprises: a locking guide surface (see surface of 231) having a locking region (see region occupied by follower pin 13 in figure 4B); and a locking follower assembly (13, 231,

212) including the push-button (231) with a follower pin (13) disposed thereon,

- wherein the locking follower assembly further comprises a biasing member (see 212 in figure 4, or 23) associated with the push-button,
- wherein the first suspension setting is substantially rigid (C3/L25-50, the position of the actuator shown in figure 4B)
- wherein the adjustment assembly comprises an adjustment guide surface (21, or 212) and a translationally adjustable mating pin (12, or 13) configured to engage the adjustment guide surface.
- Wherein the pivot axis of the lever arm (22) is substantially parallel to an axis of the handlebar (C).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 1, 2, 11-15 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kuo US 6,767,024 in view of Girvin US 6,382,370.

Kuo discloses:

- a body (30) attachable to a handlebar (C) of the handlebar-steered vehicle (see bicycle in figure 2);

Art Unit: 3656

- an actuator assembly (21, 22) including a lever arm (see arm portion of 22) in pivoting engagement with the body about a pivot axis,
- the lever arm associated with a suspension adjust cable (B) ;
- an actuator control assembly (13, 231, 212, 20, 111, 113, 11), the actuator control assembly including:
 - a locking assembly (13, 231, 212) associated with each of the body and the actuator assembly,
 - an adjustment assembly (20, 111, 113, 11) associated with each of the body and the actuator assembly,
 - wherein the first suspension setting is substantially rigid (C3/L25-50, first suspension setting corresponds to the lockout position shown also in figure 4B).
 - wherein the pivot axis of the lever arm is substantially parallel with an axis of the handlebar (see figure 1, pivot axis of the lever arm is shown parallel with axis of handlebar)
 - wherein the lever arm further includes: a cable securing assembly (see figures 4-4B, cable B is secured into lever 22); and an actuation tab (actuation tab is upper portion of 22).
 - wherein a cable moment arm created by the cable securing assembly and the pivot axis is smaller than an actuation moment arm created by the actuation tab and the pivot axis (see figures 4-4B, cable securing

Art Unit: 3656

assembly is shown radially inward of actuation tab, thus resulting in a smaller moment arm).

- wherein the body further comprises an attachment assembly (30 is concentrically mounted around handlebar C) including a ring clamp capable of substantially concentric position about the handlebar.

Kuo discloses a suspension adjust cable actuator with a pivot axis. Kuo does not disclose a pivot axis spaced apart from an axis of the handlebar. Girvin teaches an actuator (15) with a pivot axis spaced apart from (see figure 1) an axis of the handlebar (13). Because both Kuo and Girvin teach suspension adjust cable actuators, it would have been obvious to one having ordinary skill in the art at the time of the invention to substitute a pivot axis spaced apart from an axis of the handlebar for a coaxial pivot axis to achieve the predictable result of actuating a suspension adjust cable.

Allowable Subject Matter

4. Claims 7-10, 24, and 25 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

5. Applicant argues "Examiner mischaracterizes the structure and function of Kuo, giving it adjustment capabilities that it does not have, nor can have, without re-engineering. Examiner describes an adjustment range of Kuo corresponding to approximately 90 degrees between reference character 11 and stop device 13 in FIG. 4, when in fact, Kuo can only be positioned at the end points, at reference character 11 or at stop device 13, and not at any point therebetween. Indeed, lever 22 is either held in the locked position (spring 231 wedged against stop device 13), or upon release of the spring 231, the lever 22 is automatically rotated back to its operative position (near reference character 11) by the tensioned control cable B, in turn biased by the torsion spring 612 connected to the cap 61. Accordingly, the lever 22 cannot be positioned within a range of alternative second suspension settings precisely because Kuo is entirely missing an "adjustment assembly configured to position the actuator assembly relative to the body in the second position" as claimed in the present invention. Kuo only permits lever 22 to be positioned in a single locked position or alternatively a single operative position. For this reason, the 102 rejection should be withdrawn"

6. In response, the device of Kuo is capable of being adjusted within a range of alternative second suspension settings independent of the first suspension setting. For

Art Unit: 3656

example, see figures 4, 4a, and 4b,. The adjustment range corresponds to an angular range of approximately 90 degrees shown between reference character 11 and stop device 13. In another example it can be seen that the position shown in figure 4a is clearly between the either of the positions shown in figure 4 and figure 4b.

7. Applicant asserts that "...the lever 22 is automatically rotated back to its operative position (near reference character 11) by the tensioned control cable B, in turn biased by the torsion spring 612 connected to the cap 61...", however this assertion lacks merit and is in fact a mischaracterization as Kuo clearly discloses that "When rotating the lever 22 in opposite direction and back to its operative position, the cap 61 is rotated by the torsion spring 612 automatically" (C3/L40-43). That is to say, it is not the lever 22 which is rotated automatically by spring 612, but rather, the cap 61, and this only occurs "when rotating the lever 22". Therefore it can be seen that lever 22 does not automatically rotate, as asserted by applicant. As such, the device of Kuo is clearly capable of being positioned within a range of alternative second suspension settings, for example, corresponding to any lever position between reference character 11 and 13, or, for example, in the position shown in figure 4a.

8. Additionally, the claim language "configured to" followed by functional language within the apparatus claims is given limited patentable weight. The Kuo device is capable of the claimed functions. The examiner notes while features of an apparatus may be recited either structurally or functionally, claims directed to >an< apparatus must be distinguished from the prior art in terms of structure rather than function. The

Art Unit: 3656

reference discloses all claimed structural limitations and therefore anticipates the claim.

See MPEP 2114.

Conclusion

9. This is a continuation of applicant's earlier Application No. 10/707,019. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, THIS ACTION IS MADE FINAL even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

/Terence Boes/

Examiner, Art Unit 3656

Application/Control Number: 10/707,019

Page 10

Art Unit: 3656

/Richard WL Ridley/

Supervisory Patent Examiner, Art Unit 3656